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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Tomoo Tsunenari

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EXAMINER

POND, ROBERT M

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 08/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/612,945

Applicant(s)

TSUNENARI, TOMOO

Examiner

Robert M. Pond

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MLW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

The Applicant filed a Request for Continued Examination under 37 CFR 1.114. All pending claims (1-27) were examined in this non-final Office Action.

Response to Arguments

Applicant's arguments, see Remarks, filed 30 July 2004, with respect to the rejection(s) of claim(s) 1-27 under 35 USC 103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of USPS (Paper #12) and WorldSpy. USPS and WorldSpy teach online processing and shipping label printing for consumer returned product(s). WorldSpy teaches automatic determination of returned product's destination and automatic determination of best routing and cheapest carrier price among a finite list of potential carriers.

As committed in the interview with the Applicant's attorney held on 13 July 2004, the Examiner took a fresh look at the prior art cited in the final Office Action. In light of WorldSpy teachings, the examiner withdrew SmartShip, Lidisky, and Williams. Caldwell (Paper #12, Item: UUU) provided previous WorldSpy teachings and therefore was integrated into a collection of prior art that more fully teaches WorldSpy's commerce processes. PR Newswire (Paper #12), Martin

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(Paper #12), and Gralla (Paper #4) were retained as providing strong supportive teachings for dependent claims.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

- 1. Claims 23-27 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

The Examiner is asking the Applicant to clarify. The Applicant is claiming non-statutory subject matter but the preamble suggests the Applicant is attempting to claim statutory subject matter. As a suggestion, the Applicant may consider using language that conveys a computer program product embodied in computer readable medium executable on a computer, or comparable preamble language to overcome rejection under 35 USC 101.

The Applicant is claiming software code. Claims to computer-related inventions that are clearly nonstatutory fall into the same general categories as nonstatutory claims in other arts, namely natural phenomena such as magnetism, and abstract ideas or laws of nature that constitute "descriptive material." Abstract ideas, *Warmerdam*, 33 F.3d at 1360, 31 USPQ2d at 1759, or the mere manipulation of abstract ideas, *Schrader*, 22 F.3d at 292-93, 30 USPQ2d at 1457-58, are not patentable. Descriptive material can be

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characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs that impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data.

Both types of "descriptive material" are nonstatutory when claimed as descriptive material per se. Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir.1994) (claim to data structure stored on a computer readable medium that increases computer efficiency held statutory) and Warmerdam, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory). When nonfunctional descriptive material is recorded on some computer-readable medium, it is not statutory since no requisite functionality is present to satisfy the practical application

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requirement. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make it statutory. Such a result would exalt form over substance. In re Sarkar, 588 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 1978) ("[E]ach invention must be evaluated as claimed; yet semantogenic considerations preclude a determination based solely on words appearing in the claims. In the final analysis under 101, the claimed invention, as a whole, must be evaluated for what it is.") (quoted with approval in Abele, 684 F.2d at 907, 214 USPQ at 687). See also In re Johnson, 589 F.2d 1070, 1077, 200 USPQ 199, 206 (CCPA 1978) ("form of the claim is often an exercise in drafting"). Thus, nonstatutory music is not a computer component and it does not become statutory by merely recording it on a compact disk. Protection for this type of work is provided under the copyright law.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1-6, 10-13, 15-18, and 22-27 are rejected under 35 USC 103(a) as being unpatentable over USPS (a collection of prior art cited in Paper #12, PTO-892, Items: U and W), in view of WorldSpy (a collection of articles cited in Paper #12, PTO-892, Item: UUU and PTO-892, Items: U-V).**

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USPS teaches the United States Postal Service's Returns@ease software program allowing customers to notify a participating web merchant about the item(s) they wish to return and using the postal service as a returns carrier.

USPS teaches United Parcel Service's (UPS) authorized online product return service and using UPS as a returns carrier. USPS further teaches:

- Receiving

- consumer information from a first computer over a network:

Web merchant Altrec.com implementing Returns@ease for online customers to notify items they wish to return (please note examiner's interpretation: requires a first computer connected to the Internet network running a web browser to communicate with merchant web sites) (#12, U: see at least page 1); consumer goes online to access the UPS online return service (#12, U: see at least page 2); consumer name and password for access security and notification (V: see at least pages 5 and 6).

- information including product type and present location information for

the consumer product: online consumer notifies the Web merchant implementing Returns@ease about the item they wish to return (#12, U: see at least page 1); Altrec.com has all the information about the item being returned, reason, and price (#12, U: see at least page 2).

Please see below for present location information teachings.

- Storing the consumer information in a database server:

USPS teaches all the above as noted under the 103(a) rejection and teaches a) UPS's online returns shipping for consumers, b) web merchants using UPS's service receiving returns notification information from a consumers through merchant web sites, but does not disclose storing the consumer information in a database server. WorldSpy teaches reverse logistics being the handling and disposition of returned goods. WorldSpy teaches UPS's Worldwide Logistics supporting retailers in reverse logistics, and managing WorldSpy's transportation and logistics (#12, UUU: see at least pages 1-2). WorldSpy teaches WorldSpy's Web site shopping portal allowing consumers to fill out an online return notice on the WorldSpy Web site, and further teaches the Web site system using Visual Basic and Microsoft's SQL Server 7.0 database (please note examiner's interpretation: Server 7.0 database runs on second computer) (#12, UUU: see at least page 3). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to disclose a web site using a database server as taught by WordSpy, in order to more fully disclose the database server used to store information.

- Automatically determining a destination for the consumer product based upon the received product type information and the received present location of the consumer product:

USPS teaches all the above as noted under the 103(a) rejection and teaches a) automatically determining at least a single destination based on product information supplied by an online consumer (e.g. consumer

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printing shipping label destined for Altrec ships product to an Altrec facility, pre-paid printed label included with recyclable toner cartridge for later pickup by a carrier for return) (#12, U: see page 2), and b) UPS's authorized return e-shipping service for consumers. USPS, however, does not teach automatically determining a destination for the consumer product based upon the received product type information. WorldSpy teaches all the above as noted under the 103(a) rejection and teaches consumers filling out returns notices on the WorldSpy's Web site and then advising consumers where to send the items- either to a central warehouse managed by UPS Worldwide Logistics or directly back to the manufacturer (please note examiner's interpretation: product type information is used in deciding where to ship the returned item(s) to one of a plurality of return locations) (#12, UUU: see at least page 3). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of USPS to automatically determine a return location based on the product type information as taught by WorldSpy, in order to return product to a central returns facility or a manufacture's facility.

Please see below for present location information teachings.

- Automatically determining a carrier service that will deliver the consumer product to the destination based upon the received present location of the consumer product and the location of the automatically determined destination:

USPS teaches all the above as noted under the 103(a) rejection and teaches a) reverse logistics as the handling and dispositioning of returned goods back to a manufacturer or a central returns facility, b) the United States Postal Service as a return product carrier for Web merchants using Returns@ease software, and c) UPS and FedEx serving as return product carriers for merchants. USPS, however, does not disclose automatically determining a carrier that will deliver the consumer product to the returns destination. WorldSpy teaches Sears using the most efficient delivery routes to speed delivery to consumer's homes and using the same system to efficiently schedule the pick-up of consumer returned appliances (#12, UUU: see at least page 4). WorldSpy teaches the management pact WorldSpy has with UPS Worldwide Logistics as not including a bias towards UPS delivery (please note examiner's interpretation: at least one other carrier is considered). WorldSpy further teaches a purchase triggering an electronic search for the best routing and cheapest price to achieve three-day delivery to a consumer (please note examiner's interpretation: best routing requires receiving product's present location and receiving destination location) (V: see at least page 6). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of USPS to disclose using the same system used by WorldSpy to ship product efficiently to a consumer to return product efficiently from a consumer by automatically determining a carrier service based on best routing and cheapest price as taught by

WorldSpy, in order to economically ship product back from a present location to a return destination location.

Receiving present product location information

USPS and WorldSpy teach all the above as noted under the 103(a) rejection and teach a) automatically determining a carrier to economically ship product back from a present location to return destination location, b) automatically determining a returned product destination, and c) merchants paying for the consumer's returned product shipping (#12, U: see page 1), but do not disclose automatically receiving present product location information from the consumer. It would have been obvious to one of ordinary skill in the art at time of the invention to disclose automatically receiving present product location from the consumer, since one of ordinary skill in the art would ascertain that offering the best routing from the return product's location and cheapest price requires receiving present product location from the consumer, in order to determine the most economical shipping solution and thereby attract merchants to the online returns service desiring to reduce returned product shipping expenses.

- Transmitting to said first computer
 - shipping label data: Returns@ease online consumers tape the pre-paid merchandise return label printed from the merchant's Web site to the box (#12, U: see at least page 1); UPS e-shipping authorization service generates label for consumer (#12, U: see at least page 2).

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Please note examiner's interpretation: consumer's printer is operatively connected to the consumer's inline computer).

o including an identification of the automatically determined destination:

USPS and WorldSpy teach all the above as noted under the 103(a) rejection and teach a) an automatically determined return destination, and b) an automatically determined return carrier, and c) printing a return label containing product type information and destination on a printer operatively connected to a consumer's printer, but do not disclose transmitting to the first computer the automatically determined destination. It would have been obvious to one of ordinary skill in the art at time of the invention to disclose transmitting the automatically determined destination, since it is well within the skill to ascertain the automatically determined destination should be printed on the shipping label in order for the carrier to know where to ship the return product, and thereby ensure the returned product is delivered to the automatically determined destination.

o and an identification of the automatically determined carrier service:

USPS and WorldSpy teach all the above as noted under the 103(a) rejection and a) United Postal Service, UPS, and FedEx as carriers, and b) automatically determining a carrier selected among a plurality of carriers, and c) offering online returned product processing as a convenience, but do not teach transmitting to the consumer the identification of the carrier service. It would have been obvious to one

of ordinary skill in the art at time of the invention to disclose transmitting carrier identification, since one of ordinary skill in the art would ascertain the need to include carrier identification on the shipping label for consumer awareness convenience or carrier's business convenience, and thereby prevent automatically determined carrier from inadvertently shipping another carrier's package.

- Consumer information includes product serial number data; name, address, and password:

USPS teaches all the above as noted under the 103(a) rejection and teaches a) Altrec's customer service people having all the information about a product being returned, and b) return authorization, but does not disclose product serial number data. WorldSpy teaches Great Plains Software's Returns Management module tracking returned parts throughout the repair process and interfacing with other modules to update inventories, issue credits, generate purchase orders, and handle other functions associated with customer service (#12, UUU: see page 5). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to receive the returned product's serial number and thereby track returned product by serial number to update inventory and customer service as taught by WorldSpy, in order provide the returns product service with all the information necessary to coordinate returned product processing throughout an organization.

Pertaining to system Claims 1-6, 15-18, and 22

Rejection of Claims 1-6, 15-18, and 22 is based on the same rationale as noted above.

Pertaining to Claims 23-27

Rejection of Claims 23-27 is based on the same rationale as noted above.

3. **Claims 7, 9, and 19-20 are rejected under 35 USC 103(a) as being unpatentable over USPS (a collection of articles cited in Paper #12, PTO-892, Items: U-X) and WorldSpy (a collection of articles cited in Paper #12, PTO-892, Item: UUU and PTO-892, Items: U-V) as applied to Claims 1 and 16, further in view of PR Newswire (Paper #12, PTO-892, Item: WW).**

USPS and WorldSpy teach all the above as noted under the 103(a) rejection and teach a) a recyclable toner cartridge as a returnable product, and b) the consumer printing the return shipping label on a printer operatively connected to the consumer's printer, and c) printing on any printer (U: see page 2; W: see page 1), but do not specifically disclose a laser printer toner cartridge as a returnable recyclable product. PR Newswire teaches Canon USA introducing new laser printers into the market place, the use of laser toner cartridges, Canon USA instituting the Clean Earth Campaign in 1990 which supports environmental issues, and collecting millions of toner cartridges for recycling and reuse (#12, WW: see at least pages 1-3). Therefore it would have been obvious to one of ordinary skill in the art to modify the system of USPS and WorldSpy to disclose laser printer toner cartridges as returnable product for recycling as taught by PR

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Newswire, in order to attract consumers desiring to return recyclable laser toner cartridges.

- 4. Claims 8 and 21 are rejected under 35 USC 103(a) as being unpatentable over USPS (a collection of articles cited in Paper #12, PTO-892, Items: U-X), WorldSpy (a collection of articles cited in Paper #12, PTO-892, Item: UUU and PTO-892, Items: U-V), and PR Newswire (Paper #12, PTO-892, Item: WW), as applied to Claims 1 and 20, further in view of Martin (Paper #12, PTO-892, Item: XX)**

USPS, WorldSpy, and PR Newswire teach all the above as noted under the 103(a) rejection and teach a) citing reasons for returning a product, and b) Canon recycling printer cartridges, but do not disclose the use of a chip adapted to a printer cartridge to collect product information. Martin teaches a) laser printer toner cartridge recycling, b) Canon competitors producing Canon compatible cartridges, and c) introduction of smart supplies used in laser printers, and by example the Lexmark LaserJet 8100 cartridge having chips that provide feedback to users on toner usage and other information (#12, XX: see at least page 2). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system of USPS, WorldSpy, and PR Newswire to include a chip adapted to a product to provide product information as taught by Martin, in order to facilitate returned product processing.

- 5. Claim 14 is rejected under 35 USC 103(a) as being unpatentable over USPS (a collection of articles cited in Paper #12, PTO-892, Items: U-X) and WorldSpy (a collection of articles cited in Paper #12, PTO-892, Item: UUU and PTO-892, Items: U-V) as applied to Claim 10, further in view of Gralla (Paper #4, PTO-892, Item: V).**

USPS and WorldSpy teach all the above as noted under the 103(a) rejection further teach transmitting information via a web interface, but do not disclose the use of a cookie to pass or collect information from the customer's computer. Gralla teaches the use of cookies by Internet web sites to pass and collect information from a web client computer. Gralla teaches cookies as bits of data being deposited on a client's hard disk when visiting the web site, and the cookie being used to convey information to the server (#4, V: see all pages). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of USPS and WorldSpy to use the customer's cookie as taught by Gralla, in order to make it easier to conduct electronic business with a web server.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mr. Robert M. Pond** whose telephone number is 703-605-4253. The examiner can normally be reached Monday-Friday, 8:30AM-5:30PM Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Mr. Vincent Millin** can be reached on 703-308-1065.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **703-308-1113**.

Any response to this action should be mailed to:

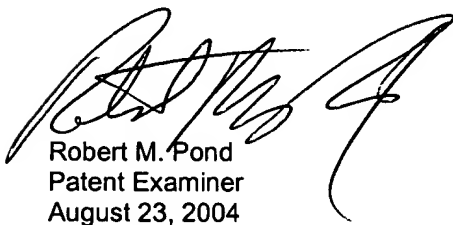
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or faxed to:

703-872-9306 (Official communications; including After Final communications labeled "Box AF")

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.



Robert M. Pond
Patent Examiner
August 23, 2004